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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,004	12/29/2004	Raymond Hallot	33900-169PUS	7014
27799 7590 11/14/2008 COHEN, PONTANI, LIEBERMAN & PAVANE LLP 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176				
EXAMINER				
HOOK, JAMES F				
ART UNIT		PAPER NUMBER		
3754				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/520,004

**Applicant(s)**

HALLOT ET AL.

**Examiner**

James F. Hook

**Art Unit**

3754

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 9, 15-23, 25, 26 and 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8, 10-14, 24 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund. The reference to Baylot discloses the recited device for thermally insulating at least one undersea pipe comprising a thermally insulating covering 4 made of a phase change material including an alkane material combined with wax provided around pipes 1, a second insulating layer 2 also provided around the pipes 1, an outer leak proof case 3<sub>1</sub> as seen in figure 15 to be rectangular in shape and thus meeting the limitations of claim 24 and 27, and where the pipe is surrounded in a continuous manner, where the phase change material meets all of the requirements of claims 10 and 13. The reference to Baylot discloses all of the recited structure with the exception of providing a container around the insulation layer within the outer protective case. The reference to Sigmund discloses that it is old and well known in the art of insulated pipes to provide an inner insulation 25, an outer

insulation 28, a leak proof protective case 26 all surrounding a pipe 14, where the insulations can be separated by flexible containers seen as any of 90,103, 91,92,110 to separate the different layers of insulation materials or not to provide these coating layers. It would have been obvious to one skilled in the art to modify the insulation in Baylot by providing coating layers to act as flexible containers for the insulation layers as suggested by Sigmund where such teaches the equivalence of either not using coatings or providing coatings as desired where there are added beneficial qualities that are provided by the coating layers where one skilled in the art would find it obvious to provide a layer if desired as Sigmund suggests.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund as applied to claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 above, and further in view of Ohm (438). The reference to Baylot as modified discloses all of the recited structure with the exception of specifically using the phase change material inside of the second insulation. The reference to Ohm discloses that it is old and well known in the art to provide a pipe 12 with an insulation material including an inner phase change insulation layer 22, and a second outer insulation layer 24 of conventional insulation, where a outer case 14 is provided. It would have been obvious to one skilled in the art to modify the insulation layers in Baylot as modified such that the phase change material was located inside of the second insulation material as suggested by Ohm where such is an alternate form of providing insulation to a pipe in subsea applications, where the outer insulation layer helps retain and protect the phase change material thereby insuring better temperature control of the inner pipe.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baylot (WO 00/40886) in view of Sigmund as applied to claims 1, 2, 6, 7, 10, 11, 13, 14, 24, and 27 above, and further in view of Davis. The reference to Baylot as modified discloses all of the recited structure with the exception of disclosing the use of heptacosane as the phase change material. The reference to Davis discloses that it is old and well known in the art of phase change materials to use heptacosane as a known phase change insulating material. It would have been obvious to one skilled in the art to modify the phase change material in Baylot as modified to be of any equivalent form of phase change material including heptacosane as suggested by Davis which teaches this is an old and well known phase change material used in insulation layers and would provide an alternate material having different properties than the alkane used in Sigmund as modified.

### ***Response to Arguments***

Applicant's arguments filed July 18, 2008 have been fully considered but they are not persuasive. The main argument offered is directed at the reference to Sigmund, as seen in figure 3, a layer 90 is provided which forms a container for the insulation material. The argument that a coating is not a container is not persuasive when there is no proof that the term container requires any specific structure other than holding something and clearly the coating holds within it the insulation material 25, therefore it a coating is considered a container with no further evidence provided to the contrary, where the arguments appear more specific than the claim language requires where the

coating 90 is a container in the broadest reasonable sense. It is also not considered persuasive that based on the teachings of Sigmund, that one skilled in the art would not be motivated to cover any insulation structure regardless of whether such is provided in a matrix or not. Specifically, Sigmund is being used to teach adding a containing structure to an inner insulation layer to separate such from the remaining structure and protect the insulation, it is considered such would also provide this same function when applied to any other insulation material including a phase change material even if such were provided in a matrix.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Best, Holman, Alderman, Hallot, and Chiesa disclosing state of the art insulations and pipe insulation systems.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James F. Hook/  
Primary Examiner, Art Unit 3754

JFH